

REMARKS

Applicant has attached hereto a Declaration under 37 CFR 1.132, executed by one of the co-inventors of the subject application to challenge statements of the Examiner in the Final Rejection made without support from any cited reference with the objective of placing the application in condition for allowance or, in the alternative to crystallize the issue of “inherency” raised by the Examiner, which applicant refutes for purposes of appeal. In addition, applicant has made some minor amendments to clarify claim 1 and to emphasize that the game system is executing an interactive communication game between the apparatuses of two or more independent communication games. No new issue is being raised by this amendment.

The rejection of claim 1 and 3 under 35 USC 102(b) as being anticipated by Freeman et al (6,356,288) is respectfully traversed. Anticipation requires the four corners of a single, prior art document to describe every element of the claimed invention. See Xerox Corporation v. 3 Com Corporation 458 F.3rd 1310 (Fed. Cir. 2006).

Claim 1 includes a processing unit which is adapted to execute processes for displaying on the display unit a self-control character that is controlled by an operation of the operation unit wherein the processing unit receives information pertaining to another character as controlled by an operation of at least one other game apparatus, displays the other character on the display unit based on the received information and controls a display state of the other character, such that the display state gradually changes from a normal display state, a faded display state to

a non-display state when a communication state with the other game apparatus disappears.

The cited reference Freeman '288 does not include or suggest the use of a processing unit to control the displaying state of a character displayed on a display unit such that the display state changes when the communication from the other game apparatus deteriorates and does not teach displaying on the display unit a self-controlled character that is controlled by the operation unit. Instead, the Examiner is apparently alleging that from the teaching in Freeman et al it would be inherent to apply available cinematographic effects, e.g. zoom-in, zoom-out, dummy, context switching, interlude, etc., as the game latency increases which the Examiner considers analogous to communication deterioration. The Examiner further implies that context switching e.g. "where the combatants (characters) being warped to another world where they do not face each other or in the case of introducing one or more dummy objects into the scene blocking the view or diverting the viewers" represents cinematographic techniques which would result in changing characters from a normal display state or fading display state to a non-display state.

Applicant has attached hereto a Declaration Under 37 CFR 1.132 to refute the Examiner's assumptions and allegations regarding the teaching of "inherency" in Freeman US Patent No. 6,356,288. As stated by applicant:

“The cinematographic techniques taught in the cited reference Freeman ‘288 on pages (2:38-42) inclusive of zooming in-zooming out, context switching etc., and in (1:47-2:3; and on 3:4-60) as indicated by the Examiner do not result in changing characters from a normal display state to a state which is not normal when communication with the other apparatus is degraded as is claimed in claim 1 of the subject application nor would one skilled in the art understand how the cinematographic techniques taught in the cited reference Freeman ‘288 change the display state of the character received from the other game apparatus such that the state of display is changed to a different display state when communication between the two game apparatus deteriorates.”

Accordingly, Freeman ‘288 does not teach a display state of a character changing from a normal display state to a state which is not normal in response to communication deterioration of the displayed character and this is not inherent from the cinematographic techniques taught in Freeman. Inherency is a factual finding which must be supported by the teaching of a cited reference or must be implicit from the teaching of the reference.

Anticipation under 35 USC 102(b) is a question of fact; see *Schumer v. Lab. Computer Systems PA Inc.*, 308 F.3d 1304 (Fed. Cir. 2002). To support anticipation, the Examiner must show a reference which supports what the Examiner alleges. The Manual of Patent Examining Procedure, Section 2131.01 III, states that “To serve as an anticipation when the reference is silent about an asserted inherent characteristic such gap in the reference may be filled with recourse to external evidence. Such evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference and that it would be so recognized by persons of ordinary skill” *Continental Can Company USA v. Monsanto Company* 948 F.2d 1264.

The Examiner has not shown extrinsic evidence to support the allegation of "inherency". Drawing an analogy to what is taught in a reference is not a substitute for extrinsic evidence needed to support inherency. Accordingly, the rejection under 35 USC 102(b) should be withdrawn.

Reconsideration and allowance of claims 1 and 3 is respectfully solicited.

Respectfully submitted,


Eugene Lieberstein
Registration No. 24,645

Customer # 79681

BAKER & HOSTETLER LLP
45 Rockefeller Plaza
New York, NY 10111
Tel: 212-589-4634 / Fax: 212-589-4201

MAILING CERTIFICATE

I hereby certify that this Amendment w/Declaration is being submitted to the U.S. Patent and Trademark Office via EFS Web and is addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria VA 22313-1450, on April 16, 2009.


Audrey de Souza